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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/808,414	03/12/2001	Gregory P. Lewis	MEDN117116	3502

26389 7590 06/17/2004

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EXAMINER	
KOPPIKAR, VIVEK D	

ART UNIT	PAPER NUMBER
3626	

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/808,414	LEWIS ET AL.	
	Examiner	Art Unit	
	Vivek D Koppikar	3626	MW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 March 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *5*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Status of Application

1. This communication is in response to the non-provisional application filed by the applicants on March 12, 2001 which is a continuation-in-part (CIP) of application with the serial number 09/523,569 (which is now abandoned). (Applicants also filed a PCT application related to this application on March 12, 2001 with the PCT application number PCT/US01/08062). The Information Disclosure Statement (IDS) statement filed by the applicants on June 25, 2001 has been acknowledged by the examiner. Claims 1-18 are pending in this application and have been examined.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 7-10 and 12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

(1) whether the invention is within the technological arts; and

(2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to

pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 7-10 and 12 only recite an abstract ideas. The recited steps of accessing healthcare information for a patient does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by the use of paper and hands which navigate through the paper to show various sections of anatomy.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

5. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4, 6-10, 12-16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent Number 6,383,135 to Chikovani.

Chikovani is directed towards a system and method for providing self-screening of patient systems.

As per claim 1, which is directed towards a computer-executable component for enabling a user to access healthcare information, Chikovani teaches an anatomic user interface for displaying an anatomic model from which the user selects an anatomic structure of interest, wherein upon selection of the anatomic structure, the anatomic user interface displays the healthcare information, wherein the healthcare information comprises medical history information for a patient including healthcare service order information, medical event information and medical encounter information (Figures 3-4, Col. 4, Ln. 32-61; Col. 5, Ln. 47-53; Col. 6, Ln. 20-30; Col. 7, Ln. 35-40 and Claim 12).

As per claim 2, Chikovani comprises a means wherein the healthcare service order information comprises a treatment plan for a patient consisting of a predetermined sequence of healthcare service orders (Col. 6, Ln. 44-50).

As per claims 3-4 and 6, Chikovani teaches a means comprising an order engine for submitting an order (or a plurality of orders) for at least one healthcare service to a service provider (the orders comprise treatment plans) (Col. 5, Ln. 66-Col. 6, Ln. 3 and Col. 6, Ln. 27-30).

As per claim 7, which is similar in all respects to Claim 1 except that it is directed towards a method claim, Chikovani teaches the all the recited steps for claim 7 (see the paragraph addressing claim 1 above).

As per claim 8, Chikovani teaches a means wherein the healthcare service order information comprises a treatment plan for a patient consisting of a predetermined sequence of healthcare service orders (Col. 6, Ln. 44-50).

As per claims 9-10 and 12, Chikovani teaches a means comprising an order engine for submitting an order (or a plurality of orders) for at least one healthcare service to a service provider (the orders comprise treatment plans) (Col. 5, Ln. 66-Col. 6, Ln. 3 and Col. 6, Ln. 27-30).

As per claim 13, which is directed towards a system for accessing healthcare information, Chikovani teaches a means for displaying anatomic model of the patient, enabling a user to drill down to and select an anatomic structure of the patient from a higher-level anatomic model, displaying healthcare information associated with the selected anatomic structure (Figures 3-4, Col. 4, Ln. 32-61; Col. 5, Ln. 47-53; Col. 6, Ln. 20-30; Col. 7, Ln. 35-40 and Claim 12). This system or application resides on an application server which a) receives the selected anatomic structure from the user computer and b) provides the user computer with healthcare information associated with the selected anatomic structure for display, wherein the healthcare information comprises medical history information for a patient including healthcare service order information, medical event information and medical encounter information (Col. 3, Ln. 64-Col. 4, Ln. 20).

As per claim 14, Chikovani comprises a means wherein the healthcare service order information comprises a treatment plan for a patient consisting of a predetermined sequence of healthcare service orders (Col. 6, Ln. 44-50).

As per claims 15-16 and 18, Chikovani teaches a means comprising an order engine for submitting an order (or a plurality of orders) for at least one healthcare service to a service provider (the orders comprise treatment plans) (Col. 5, Ln. 66-Col. 6, Ln. 3 and Col. 6, Ln. 27-30).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

7. Claims 5, 11 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent Number 6,383,135 to Chikovani as applied to claims 1, 7 and 13, above, respectively.

As per claims 5, 11, and 17, Chikovani fails to expressly teach an order engine which automatically notifies the user in real-time if the order is accepted by the service provider or if the authorization for the order is received form the payor. However, this feature is well known in the art and the Examiner takes Official Notice of the use of automated acknowledgements within the prior art. For example, it is well established that e-mail communications systems typically allow a user to automatically indicate a "read-receipt" of a sent or transmitted communication. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included a real-time notification feature within the Chikovani system with the motivation of providing the user a firm acknowledgement of order status, namely, as to whether their order had been accepted or authorized.

Further, since the knowledge and use of automated acknowledgements, in general, has clearly existed in the art prior to Applicant's claimed invention and the courts have held that even if a patent does not specifically disclose a particular element, said element being within the knowledge of a skilled artisan, the patent taken in combination with that knowledge, would put

the artisan in possession of the claimed invention. *In re Graves*, 36 USPQ 2d 1697 (Fed. Cir. 1995).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent Number 6,684,276 and US Patent Application Publication 2001/0037334 are directed towards patient medical record systems.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Vivek Koppikar** whose telephone number is **(703) 305-5356**. The examiner can normally be reached on Monday-Friday from 8 AM to 5 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned are (703) 872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

VK

Vivek Koppikar

6/14/04

Joseph Thomas

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